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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 16

Application Number: 08/610,758
Filing Date: March 5, 1996
Appellant(s): Yutaka Nakatsu et al.

Ronald P. Kananen
For Appellant

EXAMINER'S ANSWER

This is in response to appellants' brief on appeal filed on March 19, 1999.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The brief includes a statement that claims 1-7 stand or fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

4,937,676	Finelli et al.	6-1990
5,621,492	Beveridge et al.	4-1997
4,935,763	Itoh et al.	6-1990
5,561,462	Nagano	10-1996

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CAR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103{c} and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1, 3, and 5- 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finelli et al. (U.S. 4,937,676) in view of Beveridge et al. (U.S. 5, 621,492).

Regarding claim 1, Finelli '676 discloses, in Fig. 1, a video for printing on a printing paper as a hard copy (col. 6, lines 55-65), and the printer comprising: printer housing (12) to which a video camera (10) can be attached. As shown in Fig. 3, once the two are attached, they can communicate with each other through an interface (108, 112). Fig. 1 of Finelli '676 further

shows that both the camera and the printer include an operation system (42 and 64, respectively). As discussed in col. 6 in the last paragraph, these interface systems can be used interchangeably. This is, the interface system on the printer can be used to control the camera.

It is noted that Finelli '676 discloses that a video picture from a plurality of video pictures recorded by the video camera is selected by the user (see Fig. 3, col. 2, lines 30-40, col. 5, lines 5-50), however, Finelli '676 does not explicitly show the use of a video camera which is capable of capturing continuous motion images, so that one video picture from a plurality of continuous video pictures can be selected.

However, the above mentioned claimed limitation is notoriously well-known in the art as evidence by Beveridge '492. Moreover, Beveridge '492 teaches the use of the video camera (14) which capture a continuous motion images. In this way, the user can select a single desired video image from the continuous sequence of video images captured by the video camera (14) without wasting both people's time and cost (see Figs. 1 and 2; col. 2, lines 25-30, col. 3, lines 35-40).

Therefore, having the system of Finelli '676 and then given the well-established teaching of Beveridge '492, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Finelli '676 by providing the teaching of Beveridge '492 in order to provide low cost system for taking a self-portrait which allows a user a choice of a desired pose to be printed on a hard-copy medium without wasting users' time as taught by Beveridge '492 (see col. 1 and 2 of Beveridge '492).

As for claim 3, Finelli '676 shows in Fig. 2 that the printer has a pair of guide rails (74, 76) for mounting the camera so that the electrodes (78) of the two devices are lined up.

As for claims 5-6, Fig. 3 of Finelli '676 show that the printer includes a memory (80) which stores images transmitted to the printer from the camera.

As for claim 7, Finelli '676 shows a video camera operation switch and a printer operation switch (col. 3, lines 15-25 and lines 45-55).

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Finelli '676 in view of Beveridge '492 as applied to claims 1, 3 and 5-7 above, and further in view of Itoh et al. (U.S. 4,935,763).

Regarding claim 4, the combination of Finelli '676 and Beveridge '492 show that the printer includes a LCD display for displaying the images transferred from the video camera (see Fig. 1 of Finelli '676, and col. 2, lines 25-30; and Figs. 1 and 2 of Beveridge '492). Further, Finelli '676 discloses that images may be continuously shown on the display in a "shuttle ring" fashion (see col. 6, lines 35+).

However, the combination of Finelli '676 and Beveridge '492 do not explicitly show that the play mode, pause mode, fast-forward mode or rewind mode is displayed on the picture screen of a LCD monitor as specified in claim 4.

The above mentioned claimed limitations are notoriously well-known in the art as evidence by Itoh '763. Furthermore, Itoh '763 teaches that the play mode, pause mode, fast-forward mode or rewind mode is displayed on the picture screen of the LCD monitor in order to minimize the camera operation error and further enhance the user's conveniences (Fig. 12, col. 20, lines 10-30).

Therefore, having the system of combination of Finelli '676 and Beveridge '492 and then given the well-established teaching of Itoh '763, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Itoh '763 to the system of Finelli '676 for the purpose of minimizing the camera operation error and further enhancing the user's conveniences as suggested by Itoh '763.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Finelli '676 in view of Beveridge '492 as applied to claims 1, 3 and 5-7 above, and further in view of Nagano et al. (U.S. 5,561,462).

Regarding claim 2, Finelli '676 does not explicitly state that the video camera includes a LCD display which the user uses to visually confirm images while the camera is attached to the printer. Finelli '676 shows that the printer includes a LCD display which is used by the suer to visually confirm images.

However, it is notoriously well-known in the camera art that cameras include LCD displays. Nagano '462 is an example of an electronic still camera which includes a LCD display. As stated in col. 5, lines 50+, this LCD displays images. This make the camera more adaptable to being used while separated from the printer (as Finelli '676 states that it may be used) because the user may see the pictures without needing the bulk of having the camera connected to the printer if a printing function is not desired. For this reason, it would have been obvious to include a LCD display on the camera body, along with or instead of, the display located on the printer so that the user can view images when the camera is separated form the printer.

(11) Response to Argument

Regarding Claim 1, Appellants argue (pages 7 and 10) that "there is no teaching or suggesting in Finelli '676 of printing an image selected from a plurality of images recorded as continuous," and "In combination, Finelli '676 and Beveridge '492 do not teach or suggest printing a video picture selected from a plurality of video pictures recorded by a video camera as continuous motion images. Instead, the combination teaches and suggests printing an image taken as a "still" or "frozen" image."

In response, the Examiner disagrees because the presented claimed invention only required "a video picture (i.e., which is a single picture) selected from a plurality of video pictures recorded by a video camera as continuous motion images," and such limitations are

clearly read on the combination of Finelli '676 and Beveridge '492. Moreover, It is noted that Finelli '676 discloses that a video picture from a plurality of video pictures recorded by the video camera is selected by the user (see Fig. 3, col. 2, lines 30-40, col. 5, lines 5-50), however, Finelli '676 does not explicitly show the use of a video camera which is capable of capturing continuous motion images, so that one video picture from a plurality of continuous video pictures can be selected.

However, the above mentioned claimed limitation is notoriously well-known in the art as evidence by Beveridge '492. Moreover, Beveridge '492 clearly teaches the use of the video camera (14) which capture a continuous motion images. In this way, the user can select a single desired video image from the continuous sequence of video images captured by the video camera (14) without wasting both people's time and cost (see Figs. 1 and 2; col. 2, lines 25-30, col. 3, lines 35-40). Thus, it is clear form col. 2, lines 20-30 and col. 3, lines 35-60 of Beveridge '492 that upon request from the user, the frame grabber (22) selected a single video image from a plurality of video pictures recorded by a video camera (14) as continuous motion images.

In view of the above, having the system of Finelli '676 and then given the well-established teaching of Beveridge '492, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Finelli '676 as taught by Beveridge '492, since Beveridge '492 states at col. 1, line 40 - col. 2, line 15 that

such a modification would provide a self-service photographic system which is operable by a user without wasting both people's time and cost.

Given the foregoing, the Examiner has clearly established *prima facie* obviousness and the Examiner believes that the explanations of how the limitations of claims 1-7 read on Finelli '676 in view of Finelli '676 and further in view of Itoh '763 and Nagano '462 are adequately set forth in the 103 rejections as stated above.

Further, Appellants argue (pages 11-12 of the brief) that the combination of Finelli '676 and Beveridge '492 is not proper because "Combining Finelli '676 and Beveridge '492 impermissibly requires substantial reconstruction and redesign of the elements disclosed by both references to achieve the claimed invention."

In response to appellants' argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the question to be answered is what would have been obvious to a person of ordinary skill in the art to modify, given the combination of Finelli '676 and Beveridge

'492 which are related to a video printer for printing a video image on a printing paper as a hard copy? When evaluating the subject matter as a whole disclosed by the cited references the Examiner asserts one of ordinary skill in the art would have found appellants' limitations as recited in claims 1-7 obvious to implement for the reasons stated above in the 103 rejections.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

A. Moe
April 8, 1999

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